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In the Supreme Court
OF THE
United States

OCTOBER TERM, 1958

No. 904

ELRICK RIM COMPANY, a copartnership consisting of M. C. ELRICK and M. B. CHAMPLIN,

Petitioner,

vs.

READING TIRE MACHINERY CO., INC., a corporation, and RALPH R. READING, an individual,

Respondents.

PETITIONER'S REPLY BRIEF.

This brief is in reply to "Brief For Respondents In Opposition" and is filed to dissipate the erroneous contentions made in respondents' brief. It also answers Respondents' Conditional Cross-Petition For Certiorari.

ANSWER TO RESPONDENTS' ARGUMENTS.

THE GRAVER CASE IS APPLICABLE IN THE INSTANT ACTION.

Respondents claim that the doctrine of the *Graver* case has not been ignored by the lower courts; stating at page 7 of their brief that

> "The doctrines of one of the Graver cases, to wit: Graver Tank and Manufacturing Co., v. Linde Air Products Co., 339 U.S. 605, was cited and relied on by the District Court."

This statement is difficult to understand when the doctrine which the lower courts failed to apply was enunciated by this Court in a different decision, namely, the *Graver Tank* decision reported at 336 U.S. 271, rather than 339 U.S. 605.

Respondents then go on to state that the Ninth Circuit Court of Appeals followed the *Graver Tank* case, 336 U.S. 271, in *Winslow Engineering Co. v. Smith*, 223 F. 2d 438. Petitioner's complaint is that the Court of Appeals for the Ninth Circuit did not recognize, apply or follow the doctrine of said *Graver Tank* (336 U.S. 271) case in the instant action. What the Court of Appeals did in some other case has no bearing here.

Respondents, on page 8 of their brief, contend that the Reading method is operative under any superatmospheric pressure. Such is not the case. Without reference to the specification, the steps set forth in the claims of the Reading patent define an inoperative method. This is clearly established by reference to the language of the claims. Claims 1 and 2 call for the fluid in the dispersion

zone to be "at superatmospheric pressure." Claims 3 and 4 call for the pressure in the dispersion zone to be "in the range of about 5 pounds to 200 pounds per square inch." Claim 1, with respect to the pressure of air in the independent air line, calls only for "forming an independent stream of air." Claims 2, 3 and 4 call for a separate stream of air "under superatmospheric pressure". Superatmospheric pressure can be as low as 15 pounds. Therefore, a process wherein the pressure in the dispersion zone was, for example, between 15 to 200 pounds, while pressure on the independent stream of air was 15 pounds, would be inoperative. Yet this process is one defined by each of the claims of the Reading patent. It is, therefore, clearly seen that reference to the specification is necessary for a definition of the invention of each of Reading's claims.

PETITIONER'S POSITION IS NOT CONTRADICTORY AS CONTENDED BY RESPONDENTS.

Reference to the specification for the interpretation or definition of a word employed in a claim is permissible because it is an accepted rule that a patentee is his own lexicographer. In *Dennis v. Pitner*, 106 F. 2d 142, 148 (C.A. 7), the Court succinctly stated the rule as follows:

> "Every patentee may be his own lexicographer. Advance Rumley Co. v. John Lauson Mfg. Co., 7 Cir., 275 F. 249, 251; Northwest Engineering Corp. v. Keystone Driller Co., 7 Cir., 70 F. 2d 13, 15."

A reference to the specification for the definition of a single word is a far cry from a reference to the specification for a definition of the invention.

THERE CAN BE NO DOUBT THAT THE COURT OF APPEALS REFERRED TO THE SPECIFICATION TO LIMIT AND THUS SAVE THE CLAIMS.

Throughout the Court of Appeals Opinion it stresses that one of the novel features of the Reading invention was the use of a pressure in the independent stream of from 150 to 200 pounds per square inch, and when the Court of Appeals stated:

> "Appellant challenges the legal sufficiency of the specific claims set out in Reading's patent. In our view, however, the stated claims of the patent read in the light of the patent specifications are legally sufficient within the meaning of 35 U.S.C.A., Section 112." (R. 885; Appendix to Petition p. 12.),

it is clear that is necessary to refer to the specifications for the purpose of defining the invention of the claims.

THE CLAIMS DO OVERCLAIM THE INVENTION CONTRARY TO RESPONDENTS' CONTENTION.

Respondents' argument on page 12 wherein they contend that the wording of the specification (column 4, line 30), "for illustrative purposes", refers to the method disclosed in the patent, is untenable. A reading of the specification at that point discloses that the phrase "for

illustrative purposes" was not used by the patentee in reference to his method but rather to the different uses of his invention. The full context of that statement is as follows:

> "Although rubber cement can be effectively applied to many different types of articles by the use of my invention for illustrative purposes, I shall describe the use of my method and apparatus for applying rubber cement to tire carcasses." (R. 706, column 4, lines 27-32).

It is also to be noted that the only pressure stated in the specification for the independent stream of air is "150 to 200 pounds per square inch" (R. 706, column 4, lines 32-34). The claims place no such limitation on the pressure of the independent line but, on the contrary, claim 1 calls for a pressure of from 0 to infinity and claims 2, 3, and 4 call for a pressure of from 15 pounds per square inch to infinity.

In claiming such a wide range of pressures for the independent stream of air, the patentee has overclaimed his invention.

THE CLAIMS FAIL TO DEFINE THE INVENTION.

The respondents contend on page 14 of their brief that:

> "The steps in the claims here are addressed to those skilled in the art and are limited by their functional statements to cover the corresponding acts described in the specification and their equivalents."

We submit that if it is necessary to limit the steps of the claims by the corresponding acts described in the

specification, then to properly define the invention reference must be made to the specification. The language of the claims is not ambiguous, and it was heretofore pointed out that by following the specific steps set forth in the claims, an inoperative method results. This inoperativeness comes about by employing a pressure in the dispersion zone greater than the pressure used in the independent stream of air. Such an inoperative method is defined by the claims and one skilled in the art would be justified in employing such pressures when following the steps of the invention set forth in the claims.

The contention of respondents on page 15 that "Claims 2, 3 and 4 include the steps of mixing streams of emulsion and air 'to form a spray of emulsion suspended in air.'" is properly construed to embrace the exemplary acts set forth in lines 30-53, column 4 of the specification, is another admission by defendant, that reference to the specification is necessary for a proper definition of the invention.

The mere mixing of streams of emulsion and air "to form a spray of emulsion suspended in air" is not Reading's invention. Such a simple mixing will not make "possible the application of an exceedingly thin coating of rubber cement which dries quickly, thereby saving time and avoiding the dust, moisture, and health hazards"; neither will it overcome "cobwebbing"; nor will it cause "the mixture to attain and retain an air volume above the flammable limits of the solvent"; nor will it overcome "The need of extreme care to avoid the danger of fire or explosion . . .". All of these above benefits, as stated by the Court of Appeals, result only from the

use of high pressure in the independent air line. This is established when the Court of Appeals said:

> "The high pressure in the independent air line, as taught by Reading, reaches a magnitude of from one hundred fifty to two hundred pounds per square inch. This makes possible the application of an exceedingly thin coating of rubber cement which dries quickly, thereby saving time and avoiding the dust, moisture, and health hazards associated with former methods. The utilization of high air pressure in the bypass line also aids in overcoming the 'cobwebbing' effect to which reference has been made. In addition the high air pressure utilized in the Reading process causes the mixture to attain and retain an air volume above the flammable limits of the solvent. The need of extreme care to avoid the danger of fire or explosion is thus overcome." (R. 877; Appendix to Petition p. 4.)

The Court of Appeals recognized throughout its opinion that the use of a pressure of from 150 to 200 pounds in the independent air line was one of the major differences between the Reading invention and the prior art, stating:

> "In paint spraying the application of air pressure in the independent air line in the 150 to 200-pound range is unnecessary, and in fact undesirable. Likewise, there is no advantage in obtaining an emulsion effect where paint is to be sprayed. *In these two particulars Reading teaches a process not contemplated by Shelburne, Gradolph or McLean.*" (R. 878; Appendix to Petition p. 5.) (Italics ours.)
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> • • •
>
> "The trial court concluded that the use which Reading made of the known paint spraying devices

was not analogous to the uses for which they were originally designed. The Court based this conclusion on its findings of fact *that Reading was the first to use excess air pressure in the independent air line* and to obtain emulsion within the tank of liquid, both of these techniques being undesirable in the case of spray painting. In our view these two variances are sufficient to warrant the conclusion that Reading teaches a nonanalogous art and is therefore a 'new' use of a known machine within the meaning of § 100 (b)." (R. 883; Appendix to Petition p. 10.) (Italics ours.)

If the use of excessive pressure in the independent line was Reading's contribution, then the claims do not define the invention because they fail to claim such excessive pressure. As this Court said in *Altoona Publix Theatres v. American Tri-Ergon*, 294 U.S. 477, 55 S.Ct., 459:

"• • • The patent thus upheld is one which was neither claimed nor granted. Under the statute, it is the claims of the patent which define the invention. See White v. Dunbar, 119 U.S. 47, 51, 52, 7 S. Ct. 72, 30 L. Ed. 303; McClain v. Ortmayer, 141 U.S. 419, 423-425, 12 S. Ct. 76, 35 L. Ed. 800; Paper Bag Patent Case (Continental Paper Bag Co. v. Eastern Paper Bag Co.), 210 U.S. 405, 419, 28 S. Ct. 748, 52 L. Ed. 1122; Smith v. Snow, 294 U.S. 1, 55 S. Ct. 279, 79 L. Ed 721, decided January 7, 1935."

"• • • As none of the flywheel claims as drawn define an invention, none can be aided by reading into it parts of the specifications, or of other claims, which the patentees failed to include in it."

It is submitted that in holding the Reading patent valid, the lower Courts violated long-established doctrines of this Court.

THERE CAN BE NO DAMAGES FOR DELAY.

We submit that the issues raised by the Petition for Certiorari are substantial and that this Court should not permit a Court of Appeals to ignore its doctrines but rather, in the public interest and in the interest of uniformity of decisions, this Court should review the Judgment here involved.

PETITIONER'S ANSWER TO CONDITIONAL CROSS-PETITION FOR CERTIORARI.

Petitioner submits that the Conditional Cross-Petition for Certiorari should be denied. The Court of Appeals, in reviewing the evidence stated that there was no substantial evidence to support a finding that Elrick wilfully, deliberately and intentionally set out to infringe the patent, the Court further holding that the finding of fact as to intentional infringement was clearly erroneous. In this connection the Court of Appeals said:

> "* * * There could not be infringement unless Reading's process met all the conditions of patentability. The finding of fact, then, is to the effect that, having reasonable grounds for believing that Reading's process was patentable, Elrick willfully, deliberately, and intentionally set out to infringe that patent.
>
> "We do not believe that there is substantial evidence to support such a finding. Elrick certainly did not concede any such motivation. On the contrary, he testified that before entering into competition he made an examination of the ultimate results of the Reading device and method, and concluded that Reading was not entitled to patent protection.
>
> "Considered in the hindsight of this opinion, that was an erroneous conclusion. But it was not a wholly unreasonable or unfounded conclusion, since the question of patent validity, in our view, is close on both the facts and the law. Having arrived at that conclusion, Elrick proceeded in the only way that he could to test the matter—he engaged in competition, and when resisted by Reading instituted this action for a declaratory judgment.

"The finding of fact as to intentional infringement is therefore clearly erroneous.

"Under 35 U.S.C.A., § 285, an award of reasonable attorney's fees may be made to the prevailing party 'in exceptional cases.' Having concluded that the finding as to intentional infringement is erroneous, it is our view, that there is nothing else to categorize this as an 'exceptional' case warranting the imposition of attorney's fees. See Park-In Theatres v. Perkins, 9 Cir., 190 F. 2d 137, 142." (R. 886-887, Appendix to Petition pp. 13-14.)

CONCLUSION.

It is respectfully urged that, in the interests of the public and to establish uniformity in Court decisions, certiorari should be granted and the Judgment here involved reviewed by this Court.

June, 1959.

Respectfully submitted

JACK E. HURSH,

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